

Art Unit: 1623

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7, 10, 12, 13 and 15-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Wang et al (U.S. Patent No. 6,645,941).

Wang et al disclose the claimed compounds having antibacterial activity (columns 2-5) and a process for preparing the claimed compounds (columns 23-32).

Applicant's arguments filed August 6, 2009 have been fully considered but they are not persuasive.

Applicant contends that the claimed compounds are not identical to those disclosed by Wang and point out to the definition of variable "Y". This argument has not been found persuasive since Wang et al disclose the variable "Y" having that same sugar moiety (column 4, lines 45-59). Further, note that the claimed are not limited to compounds having said sugar moiety.

Claims 8, 9, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al (U.S. Patent No. 6,645,941).

Wang et al disclose 6,11-bicyclic azalides having antibacterial activity, but do not disclose the specific compounds encompassed by claims 8 and 9 and the combination of said azalides with additional antibacterial agents. However, it would have been prima facie obvious to a person having ordinary skill in the art at the time the claimed invention was made to pick various closely analogous species from the disclosure by Wang et al, because such a person would have expected said species to possess similar antibacterial activity. Further, to combine two antibacterial agents into a single composition, would have been prima facie obvious to a person having ordinary skill in the art at the time the claimed invention was made because such a person would have expected the resulting combination to possess antibacterial activity.

Applicant's arguments filed August 6, 2009 have been fully considered but they are not persuasive.

Applicant contends that there is no suggestion in Wang et al to pick particular compounds claimed by Applicant. This argument has not been found persuasive since

the specifically claimed compounds are closely related to the specific compounds disclosed by Wang et al and would be expected to possess similar antibacterial activity.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 8.00-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Jiang can be reached on (571) 272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elli Peselev
/Elli Peselev/
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